

I. Restriction Requirement

The Office Action withdraws claims 18-31 from consideration as being subject to a Restriction Requirement. On March 7, 2000, Applicants filed a Confirmation of Telephone Election in the U.S. Patent and Trademark Office to confirm the election of Group I, claims 1-17 directed to a composition. The election was made with traverse as no reasons for restriction existed on the record. Applicants hereby affirm the above election and respectfully request reconsideration and withdrawal of the Restriction Requirement.

The Restriction Requirement asserts that Group I is distinct from Group II, alleging that the product of Group I can be used in a materially different process. Although Applicants agree that the inventions of Groups I and II may be independent or distinct as claimed, Applicants respectfully submit that the Restriction between Group I and Group II is improper, and should be withdrawn.

According to M.P.E.P. § 803, there are two requirements that must be met before a proper Restriction Requirement can be made. These two requirements are: "The inventions must be independent ... or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required ... " (emphasis added). Applicants respectfully submit that the Office Action fails to establish the second requirement set forth in M.P.E.P. § 803, that a serious burden exists on the Examiner if restriction is not required between the two Groups of claims.

In the present application, Group I is directed to a composition for an EL element and Group II is directed to a method of manufacturing an EL element comprising the composition of Group I. Because it is highly likely that the results of a search of the claims of Group I would produce references that disclose both specific compositions for EL elements and specific methods for manufacturing EL elements that contain such compositions, search and examination of the subject matter of Group I would likely encompass a search for the subject

matter of Group II, and any additional search would not impose a serious burden on the Examiner.

It is therefore respectfully asserted that the search and examination of the entire application could be made without serious burden. M.P.E.P. § 803 states that "If the search and examination of an entire application can be made, without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). Because Applicants have elected Group I, directed to a composition for an EL element, the further search and examination of Group II, directed to a method of manufacturing EL elements comprising such compositions, would not place a serious burden on the Examiner.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

II. Objection to Drawings Under 37 C.F.R. § 1.81

The Office Action objects to the absence of drawings under 37 C.F.R. § 1.81. FIGS. 1-5 are added in response to this objection. FIGS. 1-5 satisfy the requirements of 37 C.F.R. § 1.81. The addition of FIGS. 1-5 does not constitute new matter, as they are supported by the brief and detailed descriptions thereof in the specification as filed. Reconsideration and withdrawal of the objection are respectfully requested.

III. Objection to Specification

The Office Action objects to the specification as including informalities. The specification has been amended to overcome this objection. The specification complies with the requirements of U.S. Patent Practice. Reconsideration and withdrawal of the objection are respectfully requested.

IV. Rejection Under 35 U.S.C. § 112, second paragraph

The Office Actions rejects claims 1-17 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 4-5, 13 and 15 are amended, and claim 3 is canceled to overcome this rejection.

In response to the Office Action's rejection of claim 14, Applicants respectfully submit that claim 14 is directed to the addition of a wetting agent to the claimed composition to prevent drying and solidification to obtain a uniform luminescence layer. Applicants further submit that claim 14 is clearly written and is appropriately supported by the disclosure on page 15 of the specification.

Claims 1-17 satisfy the requirements of 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of the rejection are respectfully requested.

V. Rejection Under 35 U.S.C. § 102(e)

Claims 1-6 and 12 are rejected under 35 U.S.C. § 102(e) as being anticipated by Shi (U.S. Patent No. 5,665,857). The Office Action alleges that the composition of Shi anticipates the claimed invention. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the rejection is improper because Shi fails to, implicitly or explicitly, teach each and every limitation of the claimed invention. More specifically, the Background of Shi discloses that a thin film is formed by mixing a fluorescent dye with a polymer having high fluorescent characteristics. The Background further discloses that it is not possible for a polymer such as PPV to exhibit sufficient fluorescent characteristics because of aggregation or crystallization of doped dyes. See Shi at col. 1, lines 15-36. Also, Shi discloses that in view of this problem, the invention of Shi is directed to providing an organic luminescent layer having a high degree of uniformity and improved efficiency by synthesizing a pendant polymer formed by chemically bonding a dye with a precursor polymer, such as PPV. See Shi at col. 1, lines 36-60.

Shi does not disclose, teach or suggest any composition, in the form of a mixture, in which a fluorescent dye is not chemically bonded with a precursor polymer, such as PPV, as claimed. See claim 1.

For at least these reasons, the claimed invention is not anticipated by Shi.

Reconsideration and withdrawal of the rejection are respectfully requested.

VI. Rejection Under 35 U.S.C. § 103(a)

Claims 7-11, 13 and 16-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shi. The Office Action alleges that even though Shi fails to teach or suggest various limitations of the claimed invention, because of further unspecified and uncited "art" the claimed invention would have been obvious. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the rejection is improper because Shi fails to teach or suggest the claimed invention. The rejection is further improper as being based upon unspecified and uncited art, apparently relied upon by the Office Action.

More specifically, in the polymer of Shi it is necessary for the dye to have bonding parts with the precursor polymer when the precursor polymer is chemically bonded with the fluorescent dye. However, depending on the type of dye used, it is often difficult to form such bonding parts in an organic synthetic manner. Therefore, the method of Shi is limited to specific cases where such bonding parts can be formed. In addition, even if synthesis is successful, Shi requires additional synthesizing steps that are not required in the claimed invention.

In contrast, the claimed invention makes it possible to obtain a luminescent layer for an organic EL element using only a composition wherein a precursor polymer is mixed, rather than being chemically bonded, with a fluorescent dye. In addition, while the composition of the claimed invention can be used with an ink-jet method, and can be

improved as a precursor by adding a wetting agent to the composition, Shi fails to teach or suggest these advantages.


For at least these reasons the claimed invention would not have been obvious over Shi. Reconsideration and withdrawal of the rejection are respectfully requested.

VI. Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that the instant application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully solicited.

Should the Examiner believe that anything further is necessary in order to place the application in condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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Attachments:

Request for Approval of Drawing Corrections
FIGS. 1-5

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